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10/706,717

11/11/2003

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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/706,717
Filing Date: November 11, 2003
Appellant(s): HARDER ET AL.

John J. Cunniff
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02 September 2008 appealing from the Office action mailed 07 February 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,979,347 B1	Wu et al.	12-2005
6,676,697 B1	Richter	1-2004
4,401,621	Unsworth et al.	8-1983

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-17 and 19-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Wu et al. (U.S. Patent No. 6,979,347 B1)** as further evidenced by Unsworth (U.S. Patent No. 4,401,621).

Wu discloses an endoprosthesis (see entire document) having a carrier structure of metallic material, wherein the metallic material comprises a magnesium alloy (for example, see column 4, lines 30-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a magnesium alloy of the composition claimed, since such magnesium alloys are well known (for example, see Unsworth's patent 4,401,621) and it has been held to be within the general skill of a worker to select a known material on the basis of its suitability for the intended use as a matter of design choice. Furthermore, it is well within the general knowledge of one having ordinary skill in the art to choose from a finite number of identified, predictable solutions, with a reasonable expectation of success. Wu discloses utilizing magnesium alloys for fabricating stents. Unsworth suggests a magnesium alloy encompassing the composition claimed. Unsworth teaches that magnesium alloys comprising such a composition are capable of giving good tensile properties over a wide range of temperatures, including ambient and elevated temperatures, and high resistance to creep while retaining satisfactory ductility, making them highly suitable for engineering applications (for example, see column 2, lines 13-45). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to try a

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well known magnesium alloy, as evidenced by Unsworth, in Wu's stent. Doing so would provide Wu's stent with the mechanical advantages described above.

Wu further discloses the stent may be self-expanding or balloon expandable (for example, see column 3, lines 41-55) produced by cutting (for example, see column 3, lines 32-35), for use in any biological or physiological lumen (for example, column 3, lines 56-65), formed by a plurality of legs (22) and connecting elements (24), carrying an active substance (for example, see column 2, lines 1-6), and coated with a drug (for example, see column 1, lines 39-43). The legs (22) have the same suitable width (W1) and the same suitable thickness (T; column 4, lines 16-29). Since the grooves formed on the plurality of legs (22) preferably have depths less than 50% of the thickness (T) of the plurality of legs (22; column 5, lines 9-10), the ratio of largest to smallest cross-sectional area and diameter of the plurality of legs is smaller or less than 2.

The functional limitations in claims 7 and 25-29 has been carefully considered, but deemed not to impose any structural limitations on the claims to make them patentably distinguishable over Wu's modified device, which is capable of performing the function as claimed.

Claims 18, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Wu et al. in view of Richter (U.S. Patent No. 6,676,697 B1)**. Wu discloses a device as described above, wherein the plurality of legs (22) form rings that are connected via connecting legs (24; column 3, line 66 - column 4, line 4). However, Wu fails to disclose the connecting legs are of a smaller cross-sectional area than the plurality of legs. Richter discloses a stent having a plurality of members and connectors

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(Figure 1). Richter teaches that reducing the width of the connectors provides the device with greater flexibility (column 6, line 44 - column 7, line 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the connecting legs of Wu's device with a smaller cross-sectional area than the legs as taught by Richter in order to provide the device with greater flexibility, which in turn allows the device to accommodate the curvature of vessels.

(10) Response to Argument

Applicant argues primarily that there is no teaching or suggestion in the cited prior art or in the knowledge generally available to one of ordinary skill in the art that a magnesium alloy containing yttrium is compatible with use in an endoprosthesis, or that such an alloy would have other properties also required in an endoprosthesis such as torsional strength, minimization of re-stenosis, or minimization of inflammation. It is the examiner's position that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wu's magnesium alloy endoprosthesis with the composition claimed, since it has been held to be within the general skill of a worker to select a known material on the basis of its suitability for the intended use as a matter of design choice. Furthermore, it is well within the general knowledge of one having ordinary skill in the art to choose from a finite number of identified, predictable solutions, with a reasonable expectation of success. Wu discloses utilizing magnesium alloys for fabricating stents. Unsworth suggests a magnesium alloy encompassing the composition claimed. Unsworth teaches that magnesium alloys comprising such a composition are capable of giving good tensile properties over a wide range of

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temperatures, including ambient and elevated temperatures, and high resistance to creep while retaining satisfactory ductility, making them highly suitable for engineering applications (for example, see column 2, lines 13-45). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to try the well known magnesium alloy, as evidenced by Unsworth, in Wu's stent. Doing so would provide Wu's stent with the mechanical advantages described above.

Regarding the applicant's argument that there is no teaching or suggestion in the cited prior art or in the knowledge generally available to one of ordinary skill in the art that such an alloy would provide advantageous properties in an endoprosthesis such as prevention of restenosis from sustained tissue growth prevention, a lack of inflammatory effect, and decomposition products that have a positive effect, it is well settled that a patent cannot be granted for an applicant's discovery of a result, even though it may be unexpectedly good, which would flow logically from the teaching of the prior art (Wu).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Melanie Tyson /M. T./
Examiner, Art Unit 3773
November 10, 2008

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